

## REMARKS

### Status of the Claims

The Final Office Action mailed November 24, 2008 notes that claims 1-41 are pending and rejects claims 1-41. Claims 1, 11, 16, 22, 23, 25, 26, 28, 29, 30, 32, 34, 36-40 are amended. No claims are cancelled. No new claims are added. No new matter is believed to be presented.

Claims 1-41 are pending and under consideration. Reconsideration is respectfully requested. The objections and rejections are traversed below.

### Objection to the Claims

At page 8, numbered paragraph 4, of the Office Action, claim 25 was objected to because "the specification fail[ed] to provide antecedent basis for the claim terminology 'computer readable storage'."

Applicants assert that the specification does provide support for the claim terminology "computer readable storage." As previously argued in applicants response of October 14, 2008, paragraph [0040] and Figure 4 of the original specification, provide support for the term "computer readable storage." For example, the second sentence of paragraph [0040] recites "This platform 40 includes a conventional storage 42 (RAM, ROM, hard disc, floppy disc, CD, DVD etc.)." Additionally, paragraph 0065 on page 11 of the original specification describes that the "system also includes permanent or removable storage, such as magnetic and optical discs, RAM, ROM, etc. on which the process and data structures of the present invention can be stored and distributed." As shown and described, the storage devices recited in the original specification are readable by a computer, and thus provide support for the claim terminology "computer readable storage" to a person of ordinary skill in the art.

On pages 2-3, numbered paragraph 2, of the November 24, 2008 Office Action, the Office Action states that because paragraph [0040] and Figure 4 recites only "storage," then the specification does not provide antecedent basis for the claim terminology "computer readable storage." Applicant respectfully disagrees.

The Federal Circuit and its predecessor court have "repeatedly held that claimed subject matter "need not be described in haec verba" in the specification to satisfy the written description requirement," so long as the specification describes the claimed invention so that one skilled in the art can recognize what is claimed. University Of Rochester v. G.D. Searle & Co., Inc.,

**358 F.3d 916, 923 (Fed. Cir. 2004) (citing In re Smith, 481 F.2d 910, 914 (CCPA 1973) and Enzo Biochem, Inc. v. Gen-Probe Inc., 323 F.3d 956, 968 (Fed. Cir. 2002)).** Here, although the original specification does not specifically recite “computer readable storage,” applicant asserts that in light of the specification as a whole, one skilled in the art would appreciate that Figure 4 and paragraphs [0040] and [0065] clearly indicate that the term “storage” refers to, and thus supports, the claim terminology “computer readable storage.”

In the interest of expediency and clarity however, applicants have amended the specification and Figure 4 to agree with the claim terminology “computer readable storage.” “The claims as filed in the original specification are part of the disclosure and therefore, if an application as originally filed contains a claim disclosing material not disclosed in the remainder of the specification, the applicant may amend the specification to include the claimed subject matter.” **MPEP 2163.06 (citing In re Benno, 768 F.2d 1340, 226 USPQ 683 (Fed. Cir. 1985).** Applicants have amended the term --storage-- to read “computer readable storage” at paragraphs [0040] and [0065], and in Figure 4, and therefore antecedent basis is established for the claim terminology “computer readable storage” recited in claim 25. Applicants respectfully request that the objection be withdrawn.

#### **Rejection under 35 U.S.C. § 112, first paragraph**

The Office Action, on page 8, in item 5, rejects claims 32-33 and 39 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. This rejection is respectfully traversed below.

The Office Action states that the specification does not describe using only independent finger motion. However, paragraph [0036] specifically states “[i]t is possible to have different “standard” arcs for different types of devices, such as a large radius shoulder arc for a white board, a medium radius elbow and/or wrist arc for a laptop computer or a digitizing tablet **and a small radius finger arc for a PDA.**” It is respectfully submitted that one of ordinary skill in the art at the time of the invention would have understood paragraph [0036] as supporting claims 32-33 and 39. This paragraph also supports claim 33, because it would be understood that a larger device, such as a white board, could have “a zone access comprising one of an elbow motion curve, a wrist motion curve and a shoulder motion curve in combination with the finger motion.” In addition, claim 39 is also supported by paragraph [0036].

Thus, paragraph [0036] read in the context of Figure 11A and with paragraph [0044] previously cited supports the above recited features. Thus, the Examiner’s assertion that “the

examiner finds no such support in the specification to support this assertion" is respectfully traversed. In the interest of expediency and clarity however, applicants have amended the specification and Figure 11A to agree with the claim terminology "independent finger motion" by adding "finger arc" to Figure 11A and paragraph [0036]. Withdrawal of the rejection is respectfully requested.

### **Rejection under 35 U.S.C. § 102**

The Office Action, on page 10, in item 7, rejects claims 32-33 and 38-39 under 35 U.S.C. § 102(b) as being anticipated by Anderson et al. (US 5,828,360). This rejection is respectfully traversed below.

Anderson discusses an apparatus for displaying a menu of options presented on the screen on a curved band. Anderson, in Figures 2(a) and 2(b) show that a user selects between two different options by rotating the wrist. (See Anderson, Abstract, Figures 2(a), 2(b) and corresponding paragraphs).

Claim 32 is amended to recite "a control zone for a function of an interface and located at least a distance equal to a typical wrist away from an edge of the display." Nothing found or cited in Anderson discloses "an interface located on the single side and at least a distance equal to a typical wrist away from an edge of the display."

Claim 39 recites similarly to claim 32 and thus patentably distinguishes over Anderson for the reasons above.

Claim 33 and claim 39 depend from claim 32 and claim 38 respectively, and thus patentably distinguish over Anderson.

### **Rejection under 35 U.S.C. § 103**

The Office Action, on page 10, in item 13, rejects claims 1-23, 25, 29-31, 34-37, and 40-41 under 35 U.S.C. § 103(a) as being unpatentable over Anderson et al. in view of Miettinen et al. (US Patent Application Publication 2002/0054175). This rejection is respectfully traversed below.

Miettinen discusses surrounding a user with a selection disc and detecting whether the user touches or penetrates the selection disc. The selection disc is displayed using a selection device 30. The selection device comprises a three-dimensional display device 35. Miettinen discusses combining **two** different arcs or zones. One of the two arcs requires rotation of an elbow while the other requires rotation of a shoulder. The Office Action also explicitly states that

"there are two areas in the interface, one for access of moving the arm with the elbow bent, i.e. rotation of the elbow, and one for a straight arm rotation, i.e. shoulder.) (See Miettinen, paragraph [0044], [0046], [0066], Office Action, page 14, lines 11-15).

While the Office Action on page 5, line 2 asserts that "Miettinen was only used to teach of using different arm motions in an interface," the Office Action admits on page 14 that "Anderson fail[s] to explicitly teach that the arc is aligned to a natural user motion produced by a compound motion of rotation of the user elbow and rotation of a user wrist." These two arguments are contradictory. This is why the Applicant made such an argument in the previous Response and continues to do so in the paragraph below. Prosecution cannot be advanced if the Examiner makes assumptions not provided in the record. (See MPEP 707, "When considered necessary for adequate information, the particular figure(s) of the drawing(s), and/or page(s) or paragraph(s) of the reference(s), and/or any relevant comments briefly stated should be included. For rejections under 35 U.S.C. 103, the way in which a reference is modified or plural references are combined should be set out.")

It is respectfully submitted that Miettinen does not teach "the arc shaped control zone aligned to a natural user motion produced by a compound motion of a rotation of the user elbow and rotation of a user wrist." Rather, Miettinen discusses two different areas in which only a single rotation of a particular body part is required. In the area closer to the body, in Figure 1, the elbow is rotated and in the area further from the body, the shoulder is rotated. Thus, Miettinen does not discuss "**the** arc shaped control **zone** aligned to a natural user motion produced by a **compound motion**." Rather, Miettinen discusses two different areas, arcs, or zones with entirely different activities tied to them which require two different singular, non-compound motions. Miettinen specifically notes that one arc corresponds with one activity and the other arc corresponds with a second, possibly opposite activity. Compound motion of rotation is not required to move in either arc, or in Anderson, as admitted by the Office Action. Withdrawal of the rejection is respectfully requested.

Claim 1 is also amended to recite "an arc shaped control zone for a function of an interface located on the single side and at least a distance equal to a typical wrist away from an edge of the display." Nothing cited or found in Anderson and Miettinen, taken alone or in combination, teaches the above recited feature. Withdrawal of the rejection is respectfully requested.

The independent claims 11, 16, 22, 23, 25, 26, 29, 30, 34, 36, and 40 are amended similarly to claim 1 and thus patentably distinguish over Anderson and Miettinen for the reasons

discussed above and with respect to the deficiencies of Miettinen.

Independent claims 37-39 are amended similarly to claim 1 and thus patentably distinguish over Anderson and Miettinen for the reasons discussed above.

The Office Action, on page 32, in item 11, rejects claims 26-28 under 35 U.S.C. § 103(a) as being unpatentable over Anderson in view of Miettinen and further in view of Ono (US 5,559,944). This rejection is respectfully traversed below.

Independent claim 26 is amended similarly to claim 1 and thus patentably distinguishes over Anderson, Miettinen, and Ono for the reasons discussed above and with respect to the deficiencies of Miettinen.

The dependent claims depend from the above-discussed independent claims and are patentable over the cited references for the reasons discussed above. The dependent claims also recite additional features not taught or suggested by the cited references. For example, claim 28 is amended according to the suggestions of the Examiner to recite "plural users are allowed to make strokes individually at different times and **the arc is determined from a combination of strokes of the plural users.**" In particular, the cited references do not teach that "the arc is determined from a combination of strokes of the plural users." Ono merely notes that a linear pull down menu is placed on a screen based on **individual calibration**. It is submitted that the dependent claims are independently patentable over the cited references.

The Office Action, on page 33, in item 12, rejects claim 24 as being unpatentable over Anderson in view of Miettinen and further in view of Ono. This rejection is respectfully traversed below.

Claim 24 depends from independent claim 23 and inherits the patentable features of claim 23. Thus claim 24 patentably distinguishes over Anderson, Miettinen and Ono, taken alone or in combination.

## Summary

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.


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If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: 2/23/9

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